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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,795	12/13/2000	Robert E. Haines	10003227-1	3806

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/738,795	Applicant(s) HAINES, ROBERT E.	
	Examiner Thierry L Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 11/12/04.
- Claims 1-26 are pending in application; Claims 21-26 are newly added.

Claim Objections

- Claims 22, 24, and 26 objected to because of the following informalities: “fist” should be placed as “first” to avoid lack of antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 23, 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide an adequate written description of the limitations as recited in claims 21, 23, 25, wherein “initial entity”, the examiner is unclear what constitutes an “initial entity”; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. Herein, the examiner interprets an “initial entity” as a PC computer 30 of fig. 1.

Claims 22, 24, 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The

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specification does not provide an adequate written description of the limitations as recited in claims 22, 24, and 26, wherein "first designation is not recognizable by entity"; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. The examiner interprets "not recognizable" as the customer product number is different than manufacturer product number; therefore, the customer product number is not recognizable by the entity.

Response to Arguments

Applicant's arguments, see pages 7-11, filed on 11/12/04, with respect to the rejection(s) of claim(s) 1-20 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohtani (US 6108099), and in view of Beauchesne (US 6128626).

Regarding claim 1, Ohtani discloses a consumable management device (*client computer 30, fig. 1*) comprising:

- an interface (*LAN I/F interface 30a, fig. 1*) configured to receive a first message including a first designation (*receiving first message from printer identifying consumable products such as empty toner and/or paper, fig. 4, col. 5, lines 4-52*) identifying an imaging consumable used by an image forming device to form hard images (*i.e. toner and/or paper, fig. 4*); and

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- processing circuitry coupled (*inherently, all computers include a CPU*) with the interface, the processing circuitry being configured to generate a second message (*an email message including "model No. and manufacture number as shown in fig. 8 for forwarding to supplier for ordering the consumable parts, cols. 5-6)* including the second designation (*i.e. "model No and part number as shown in fig. 8)*, and to forward the second message to the interface for communication to an entity (*email message is then forwarded to a supplier, fig. 4, cols. 5-6)* for assisting with replenishment of the imaging consumable.

Ohtani discloses a consumable management device, but fails to explicitly disclose wherein a processing circuitry configured to convert the first designation identifying the imaging consumable to a second designation identifying the imaging consumable.

Beauchesne, in the same field of endeavor for consumable management, teaches a processing circuitry (*client computer system 300 as shown in fig. 1*) configured to convert (*converting/corresponding/matching the manufacturer part number with customer part number, figs. 3-6, for example, fig. 5d shows component part number as a customer's part number with corresponding manufacturer's part number "mfg. Pn"*) the first designation identifying (*i.e. manufacturer's part number, figs. 3 & 5d*) the imaging consumable to a second designation (*i.e. customer's part number, fig. 3 & 5d, Beauchesne's system also includes a database for storing manufacturer's part number and customer's part number*) identifying the imaging consumable. Please also notes; it is also known in the art that before ordering any products from any manufacturers, the customers must know the part/product number and/or serial number. *Please also notes: claim 1 does not indicate what constitutes a "first and second designation message"*.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying a consumable management device of Ohtani to include a processing circuitry configured to convert the first designation to a second designation (*i.e. matching customer part number with manufacturer part number*) as taught by Beauchesne because of a following reason: (•) allowing operators/users/clients to easily match the customer's part with manufacturer's part number by utilizing the database as shown in figs. 2-6 of Beauchesne without having to contact the manufacturer for part

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number; by doing so, it reduces time consumption and costs; (●) it improves the operability of the printing system by detecting and replacing the new parts as detected by the printer's sensors.

Therefore, it would have been obvious to combine Ohtani with Beauchesne to obtain the invention as specified in claim 1.

Regarding claim 2, Ohtani further discloses the device in accordance with claim 1 wherein the interface is configured to receive another first message (another message for toner, fig. 8) including another first designation identifying another imaging consumable (i.e. toner, fig. 8), and the processing circuitry is configured to convert the another first designation into another second designation identifying the another imaging consumable, and to generate the second message comprising a list (paper supply and toner supply, fig. 6-8) including the second designations. Please also see figs. 3-6 of Beauchesne for lists of products to be ordered.

Regarding claim 3, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to generate the second message comprising a quantity (it is obvious to include a quantity within your purchase order as shown in fig. 6) corresponding to the imaging consumable identified by the second designation. Please also see figs. 3-6 of Beauchesne for quantity to be ordered.

Regarding claim 4, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to generate the second message comprising an email message and to include the second designation as an attachment of the email (attached an order form as shown in fig. 6 to an email message). It is also known in the art that email software/programs are capable of attached files to an email message.

Regarding claim 5, Ohtani and Beauchesne further disclose the device in accordance with claim 1 wherein the processing circuitry is configured to convert the first designation comprising a manufacturer part number for the imaging consumable to the

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second designation comprising a customer part number (manufacturer's part number and customer's part number as shown in figs. 3-6 of Beauchesne) for the imaging consumable.

Regarding claim 6, Ohtani and Beauchesne further disclose the device in accordance with claim 1 further comprising storage circuitry configured to store a look-up table, and the processing circuitry is configured to access the look-up table (database contains plurality of look-up-table products, fig. 4 of Beauchesne) to convert the first designation to the second designation.

Regarding claim 7, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to export the second designations into one of a plurality of formats (i.e. email message, fig. 6) corresponding to the entity to generate the second message.

Regarding claim 8, Ohtani further discloses the device in accordance with claim 1 wherein the processing circuitry is configured to communicate the second message at a predetermined moment in time (a purchase order can be sent to manufacturer at any time depends upon users' preferences). It is also known in the art to configure any email software to send out messages at predetermined moment in time.

Regarding claim 21, Ohtani further discloses the device in accordance with claim 1 wherein the entity comprises an initial entity (pc computer 30, fig. 1), and wherein the first designation is usable by another entity to identify the consumable (pc computer 30 for identifying what consumable products need to be ordered, figs. 4-8) and the second designation usable by the initial entity (a forwarded message with product number to a manufacturer, figs. 4-8 and col. 3, lines 1-5 and cols. 5-6) different than another entity to identify the consumable.

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Regarding claim 22, Ohtani further discloses the device in accordance with claim 1 wherein the first designation is not recognizable by the entity (it is known in the art that customer product number is different than manufacturer product number; therefore, the customer product number is not recognizable by the entity).

Claims 9-13, and 23-24 are referring to a system (an image forming system as shown in fig. 1 by Ohtani includes image forming apparatus 20, LAN, PC 30, and server 40) for performing the method steps that limitations that are similar and in the same scope of invention as to those in claims 1-8, and 21-22; therefore, claims 9-13, and 23-24 are rejected for the same rejection rationale/basis as described in claims 1-8, and 21-22 above.

Claims 14-20, and 25-26 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 1-8, and 21-22; therefore, claims 14-20, and 25-26 are rejected for the same rejection rationale/basis as described in claims 1-8, and 21-22 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (●) U.S. 6333790 to Kageyama, discloses a monitoring system for managing image forming apparatuses and automatically order consumable products.
- (●) U.S. 6405178 to Manchala, discloses a monitoring system for managing image forming apparatuses and automatically order consumable products.
- (●) U.S. 20020007318 to Alnwick, teaches a method for searching database for manufacturer part number with respect to customer part number.
- (●) U.S. 6798997 to Hayward et al, teaches a method for automatically reordering consumable products for image forming apparatus.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER